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9 intermediate cylinder being held relatively rotatably by a cam
10 cylinder having a cam slot for the optical system and a cam slot
11 for the imaging device, said cam slots being formed in the
12 periphery of the intermediate cylinder, and said objective lens
13 and said imaging device are allowed to slide in interlock with
14 each other while forming a predetermined distance relation in
15 response to rotation of said cam cylinder through the roller
16 projections which are engaged with the cam slots of the cam
17 cylinder through the guide slot of said intermediate cylinder.--

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, the specification and claims 1 and 5 have been amended as suggested by the Examiner. In addition, new claims 6-10 have been added. Thus, claims 1-10 are currently pending.

In the Office action mailed October 4, 1993, the Examiner noted several informalities in the specification and claims. As mentioned above, the specification and claims have now been amended as suggested by the Examiner. Accordingly, withdrawal of the objection to the disclosure is requested.

The Examiner also objected to the drawings and suggested that Fig. 13 should be labeled "Prior Art". Applicant

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is submitting herewith a Request For Approval of Drawing Changes to obtain approval of the change to Fig. 13 suggested by the Examiner. Approval of that change and withdrawal of the objection to the drawings are respectfully requested. Upon receipt of a Notice of Allowance, revised formal drawings will be submitted.

In addition, claims 1 and 3 were rejected under § 102(a) as anticipated by JP No. 4-107411. Claim 2 was rejected under § 103 as being unpatentable over the same reference. These rejections are respectfully traversed since the cited reference is not prior art with respect to this application.

The present application is entitled to the July 4, 1991 priority date of the Japanese applications on which a PCT application filed on July 2, 1992 is based. Applicant is attaching hereto a copy of a "Notification Concerning Submission of Priority Documents" received from WIPO indicating that the International Bureau received the priority documents relating to this application. The cited reference, JP No. 4-107411 was laid-open on April 8, 1992 -- more than nine months after the effective date of this application. Thus, regardless of whether JP 4-107411 discloses or suggests any of the subject matter now claimed, it is not prior art with respect to this application. The outstanding rejections based on this reference should, therefore, be withdrawn.

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Claim 1 was also rejected under § 103 as being unpatentable over Birkle. In support of this rejection, the Examiner stated:

Birkle teaches the invention substantially as claimed in claim 1, except for the light source lamp. The light source utilized in Birkle is not in the form of a lamp, rather in the form of optical fibers are nothing less than a recognized art equivalent of the lamp.

This rejection is respectfully traversed as follows.

The present invention provides a novel form of video type microscope in which the image pick-up apparatus includes both a control circuit unit of an imaging device and a light source of an illuminating system. As mentioned in the specification, these components have conventionally been provided on controllers outside of the image pick-up apparatus.

Birkle neither discloses nor suggests the claimed structure. To begin with, as noted by the Examiner, Birkle does not include a light-source lamp for lighting the object to be observed as required by the claims of this application. The Examiner evidently contends, however, that this positively recited claim limitation is satisfied by Birkle's disclosure of optical fibers which transmit light from an external source since "optical fibers are nothing less than a recognized art equivalent of the lamp". Applicants disagree with both the form and the substance of this rejection.

Substantively, applicants disagree with the contention that optical fibers are an art equivalent of a lamp light source.

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Optical fibers are a means for transmitting light from an external source into an apparatus. This is directly contrary to the present invention in which the lamp source is located within the image pick up apparatus. Thus, rather than being an "equivalent" of the structure claimed, Birkle discloses the direct opposite -- an external light source requiring optical fibers. In this regard, it should be noted that claim 1 requires "a light-source lamp" not "light-source means" (as required by claim 6, for example) which might be satisfied by optical fibers.

In addition, applicants submit that the Examiner has failed to set forth a proper prima facie case of obviousness. During the examination process, the PTO has the burden under § 103 to establish a prima facie case of obviousness. In re Fine, 5 USPQ2nd 1596, 1598 (Fed. Cir. 1988). The PTO "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Id. Where the examiner relies on a single reference under a § 103 rejection, it is not sufficient to find a prima facie case of obviousness on the basis that the prior art reference could be modified or may be capable of being modified to operate in the manner claimed. In re Mills, 16 USPQ2nd 1430, 1432 (Fed. Cir. 1990).

To establish obviousness, there must be a suggestion or motivation in the reference to do so. Id. See also In re

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Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so). The preferred method of establishing motivation or suggestion for modification is to rely on a suggestion within the primary reference or to find such a suggestion in a teaching reference.

As stated in Fine,

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall notion to the invidious effect of a hindsight syndrome.

5 USPQ 2nd at 1600 (quoting W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303, 312-13). Accord Mills, 16 USPQ 2nd at 1432; In re Demenski; 230 USPQ 313, 315 (Fed. Cir. 1986) (reversing rejection of claims where no suggestion existed in the prior art references to make proposed design modification and rejecting Board's argument as hindsight that the proposed modification was "common practice"). See also Northern Telecom, Inc. v. Data Point Corp., 15 USPQ 2nd 1321, 1323 (Fed. Cir. 1990), (rejecting "routine design choice" absent any suggestion in the prior art to make proposed modification).

Applicants submit that the Examiner has not satisfied his burden of showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead that individual to modify Birkle to arrive at the claimed invention.

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Applicants acknowledge that the MPEP provides a basis for rejection without reliance on the teachings of a reference where an examiner may take "judicial notice" (more properly "official notice") of things believed to be known or "recognized" by those of skill in the art ("well known" prior art). See MPEP § 706.02(a) ("If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state"). Here, the Examiner has not taken official notice of that which he contends is "recognized". Applicants therefore request that the examiner cite a reference in support of his or her position.

Moreover, the Examiner has identified only one difference between Birkle and the invention claimed in claim 1, i.e., Birkle does not disclose the claimed light source lamp. The Examiner's contention that Birkle teaches "the invention substantially as claimed in claim 1, except for the light source lamp" is conclusory. Applicants note for example that while Birkle discloses an imaging device (8, 27) it is not clear whether Birkle discloses a control circuit for the imaging device as claimed.

Thus, applicants submit, with all due respect, that the Examiner has failed to satisfy the requirements for a proper rejection under § 103. Accordingly, reconsideration and withdrawal of the rejection of claim 1 as unpatentable over Birkle is respectfully submitted.

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As previously noted, the foregoing amendment adds new claims 6-10. Of these, claims 6 and 7 are independent.

New independent claim 6 is drafted to include the subject matter of original claim 1 and original claim 4 which was indicated as being allowable. Please note, however, that claim 6 defines a "light-source means" rather than a "light-source lamp" as required by original claim 1. In addition, applicants wish to advise the Examiner that Japanese Patent 63-246731, which has previously been submitted by applicants and considered by the Examiner, discloses an objective lens and imaging device interlock arrangement of the type defined in original dependent claims 4 and 5. The Examiner may wish to take this into account in considering new claim 6.

New independent claim 7 combines the subject matter of original claims 1 and 2. Since original claim 2 was rejected only on the basis of JP No. 4-107411, which is not prior art, applicants submit that this claim and claims 8-10 dependent therefrom are in clear condition for allowance.

For all of the above reasons, applicants submit that this application is now in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

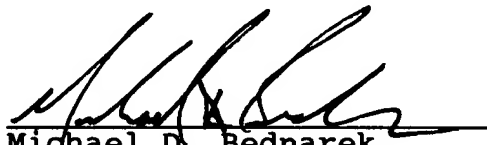
Should the Examiner determine that any further action is necessary to place this application into even better form, he

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is encouraged to telephone applicants' undersigned representative
at the number listed below.

Respectfully submitted,
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